



TECH CENTER 1600/2900

MAR 11 2002



Docket No.: 211714US0X

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/919,891
Applicants: Brigitte BATHE, et al.
Filing Date: August 2, 2001
For: NUCLEOTIDE SEQUENCES WHICH CODE FOR
THE metH GENE
Group Art Unit: 1652
Examiner: C.L. FRONDA

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SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT (5 pp.)

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO.: 211714US0X



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Brigitte BATHE, et al.

SERIAL NO.: 09/919,891

FILED: AUGUST 2, 2001

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: GROUP ART UNIT: 1652

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: EXAMINER: FRONDA

FOR: NUCLEOTIDE SEQUENCES CODING FOR THE metH GENE

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RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action dated February 7, 2002, Applicants elect, with traverse, Group I, Claims 1-9, 11, and 12, for further prosecution. Applicants note that an election of Species is not required with the election of Group I.

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 1-9, 11, and 12, drawn to an isolated polynucleotide coding for the sigH gene, a vector, an Escherichia coli strain, and a coryneform bacteria strain;
- Group II: Claim 10, drawn to a coryneform bacteria in which the sigH gene is enhanced or overexpressed;
- Group III: Claims 13-17, 20-22, and 26-28, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacteria which at least the sigH gene is enhanced;
- Group IV: Claims 13 and 18, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacteria which at least the sigH gene is enhanced

and additional genes for the biosynthesis pathway of the desired L-amino acid are enhanced;

- Group V: Claims 13 and 19, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacterium which at least the sigH gene is enhanced and the metabolic pathways which reduce the formation of the desired L-amino acid are at least partly eliminated;
- Group VI: Claims 13 and 23, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacteria which at least the sigH gene is enhanced and the regulatory properties of the polypeptide for which the polynucleotide sigH codes are increased;
- Group VII: Claims 13 and 24, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacteria which at least the sigH gene is enhanced and one or more genes are enhanced or overexpressed selected from the group consisting of the dapA, gap tpi, pgk, zwf, pyc, mqo, lysC, lysE, ilvA, ilvBn, ilvD, and zwa1 gene;
- Group VIII: Claims 13 and 25, drawn to a method for the fermentative production of L-amino acids in coryneform bacteria comprising fermenting in a medium coryneform bacteria which at least the sigH gene is enhanced and one or more genes are attenuated selected from the group consisting of the pck, pgi, poxB, and zwa2 gene; and
- Group IX: Claims 30 and 31, drawn to a method for identifying RNA, cDNA, and DNA that encode for the sigH protein comprising contacting the RNA, cDNA, or DNA with hybridization probes.

In addition, the Office is requiring an election of a single disclosed species as follows:

If Group VII (Claims 13 and 24) is elected, one of dapA, gap, tpi, pgk, zwf, pyc, mqo, lysC, lysE, hom, ilvA, ilvBN, ilvD, and zwa1.

If Group VIII (Claims 13 and 25) is elected, one of pck, pgi, poxB, and zwa2.

Applicants elect, with traverse, Group I, Claims 1-9, 11, and 12. Applicants note that an election of Species is not required with the election of Group I.

Applicants note that claims of Group I and Groups III-VIII are directly dependent from the claims of Group II, as such these groups are not separable.

Applicants also note that claims of Group IX are directly dependent from the claims of Group III, which in turn are directly dependent from Group II, and as such these groups are not separable.

In addition, Applicants note that Groups III-VIII contain Claim 13, and therefore should not be separated.

Citing MPEP §806.04 and MPEP §808.01, the Office has characterized the inventions of Groups I and II as unrelated. According to MPEP 808.01, if inventions are held unrelated, it must be shown that they are not disclosed as capable of use together. However, the office has merely stated its conclusion without providing sufficient reasons or examples. Further, Applicants note that the claims of Group I depend directly from the claims of Group II. Thus, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement and it should be withdrawn.

The Office has characterized, citing MPEP §806.04 and MPEP §808.01, the inventions of Groups III-IX as unrelated. Applicants disagree. Applicants note that Groups III-VIII contain Claim 13, and as such are clearly related and should not be separated. Furthermore, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement and it should be withdrawn.

The Office has characterized, citing MPEP §806.04 and MPEP §808.01, the inventions of Group I and Groups III-IX as unrelated. Applicants disagree. Applicants note that the claims of Groups I and III-VIII are directly dependent from the claims of Group II, as such are related and should not be separated. Furthermore, the Office has not provided sufficient reasons and/or examples to support this assertion. Accordingly, the Office has

failed to meet the burden necessary in order to sustain the Restriction Requirement and it should be withdrawn.

In regard to Groups II and (III-IX), the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office suggests that the claimed composition can be used in a materially different process “such as using the *Coryneform* bacteria in a recombinant process for the production of the enhanced sigH protein.” However, the bacteria of Group II is a component of Groups III-IX, and as such can not be separated.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office, particularly in view of the fact that Groups III-VIII are classified in the same subclass (class 435, subclass 106).

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants further submit that this application is now in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

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